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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,577	10/09/2003	Muhammed Majeed		2576

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EXAMINER

MERCIER, MELISSA S

ART UNIT PAPER NUMBER

1615

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/605,577

Applicant(s)

MAJEED ET AL.

Examiner

Melissa S. Mercier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: the inventor designated as Inventor 1, Dr. Muhammed Majeed did not date the declaration upon signing it.

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

The abstract of the disclosure is objected to because of the inclusion of the phase "said cosmetic composition". Correction is required. See MPEP § 608.01(b).

Claim Objections

Claims 2-13 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 2-13 are drawn to intended uses of the composition claimed in Claim 1. The dependent claims of intended use do not add any further limitations into what the applicants regard as their invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not provide written description for "lipophilic extracts of Garcinia or its isolates" as a genus. The specification particularly states that Garcinol and Cambogin belong to a distinct class of compounds called polyisoprenylated benzoates. Applicant has not provided written description for all isolates or derivatives of Garcinia.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. Note the format of the claims in the patent(s) cited.

Claims 2-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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applicant regards as the invention. Applicant is claiming "lipophilic extracts of Garcinia or its isolates", the term isolates is not defined in the specification. It is unclear to the examiner exactly what the applicant is claiming in the composition.

Regarding claims 2-13, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claims 2-13 recites the limitation "the composition of Claim 1" in the first line. There is insufficient antecedent basis for this limitation in the claim. While the examiner is interpreting claim 1 to be drawn to a composition, it is unclear as to whether this is what applicant has intended by the claim language of Claim 1, which states novel cosmeceutical, and pharmaceutical applications of Garcinia extract".

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte*

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Hasche, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 3 and 7 recites the broad recitation "concentrations of 0.001-10" and "0.01-10%", respectively, and the claim also recites "preferably 0.1-1%" and "preferably 0.5-2%", respectively, which is the narrower statement of the range/limitation.

Claims 3 and 7 are further rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The ranges that the applicant is stating for concentrations are outside of the ranges claimed in Claim 1, to which Claims 3 and 7 depend on. It is further unclear as to what the component is present at the concentration claimed, as Claim 1 lists two components: Garcinol and Cambogin. Clarification is requested.

The term "better" in claim 6 is a relative term, which renders the claim indefinite. The term "better" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamaguchi et al (US Patent 5,972,357).

Yamaguchi teaches health foods and cosmetics containing polyisoprenylated benzophenone derivatives." The derivatives may be prepared by any method such as the chemical synthetic method or the extraction of the polyisoprenylated benzophenone derivatives from the plant containing them. The preferred derivatives includes, for example, well known substances such as Garcinol also known as Camboginol, isogarcinol also known as Cambogin, xanthochymol, and guttiferone" (column 3, lines 14-24). Yamaguchi further teaches "the plants containing the polyisoprenylated benzophenone derivatives described are some kind of tropical plants belonging to the Guttiferae family, for example *Garcinia cambogia*, *Garcinia indica*, and *Garcinia purpurea*" (column 3, lines 28-33).

Yamaguchi's example 1 is drawn to a healthy drink with extracts. The example teaches " In the same manner as in Referential Example 1, the hydroxycitric acid extracted residue of the dry rind of the *Garcinia indica* was extracted with ethanol to give an extract containing 25% w/w of garcinol and 5% w/w of isogarcinol" (column 12, lines 56-61). The Referential Example 1 can be found in Column 6, lines 4-44.

Yamaguchi also teaches "the derivatives are effective ingredients and have a variety of functions for maintaining health such as anti-ulcer activity, the Maillard reaction inhibiting activity, anti-oxidation activity, reactive oxygen species scavenging activity and anti-tumor promotion activity" (abstract). The derivatives are also expected to have "prophylactic effects on various geriatric diseases, stress diseases, diabetic

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diseases, tumorigenesis and the aging of skin, such as hardening, wrinkling, and pigmentation" (column 2, lines 45-55).

Further regarding Claims 2-13, the Examiner is interpreting them to be drawn to an intended use of the composition claimed in Claim 1, and not to method of use claims.

Something which is old does not become patentable upon the discovery of a new property. [T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Majeed et al (PCT Publication WO 2002/14477, now US Patent 7,063,861).

Majeed teaches a composition comprising hydroxycitric acid (HCA) in combination with either one or both of Garcinol and antrocyenin. Garcinol is described as having well know anti-oxidant effects, an aid to weight loss, chemopreventive properties, inhibition of cytoplasmic citrate lysase. Majeed additionally teaches a method for extracting Garcinol by "extracting Garcinia spent fruit from suspension with toluene and 5% methanol to obtain a paste having 20% PPB's (Garcinol-15%; Cambogin 5%" (column 6, lines 14-19). In additional steps outlines, Majeed further

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teaches the purification of the Cambogin and Garcinol to increase the presentage of each present in the compositon.

Further regarding Claims 1-13, applicants attention should also be directed to Alviar et al. (US PG/Pub 2002/0187204).

Alviar teaches a diet composition including effective amounts of Garcinia cambogia extracts. Alviar states "Garcinia cabogia contains phytochemicals, Cambogin and camboginol, Garcinol and its isomer isogarcinol and anthocyanin pigments" (paragraph 15).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa S. Mercier whose telephone number is (571) 272-9039. The examiner can normally be reached on 7:30am-4pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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